

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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In re Patent Application of:  
Ari Ikonen *et al.*

Application No.: 09/587,959

Confirmation No.: 9612

Filed: June 6, 2000

Art Unit: 2623

For: DATA TRANSFER ADAPTOR AND A  
METHOD FOR TRANSFERRING DATA

Examiner: J. R. Sheleheda

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/SCOTT E. KAMHOLZ/  
Scott E. Kamholz

**APPEAL BRIEF**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Appellants submit this brief in support of their appeal initiated by the Notice of Appeal filed on February 20, 2007. The Commissioner is authorized to charge the fee required under 37 C.F.R. § 41.20(b)(2) to Deposit Account No. 06-1448, ref. NOD-001.01.

***(1) Real Party in Interest***

The real party in interest in this appeal is Nokia Corporation, a Finnish corporation having executive offices at Keilalahdentie 4, 02150 Espoo, Finland. Nokia Corporation is the Assignee of the entire right, title, and interest in the present application by virtue of

assignments from the inventors. The assignment from inventors Ikonen and Heinonen was recorded on August 14, 2000 at Reel 011056, Frame 0728, and the assignment from inventor Okkonen was recorded on August 14, 2000 at Reel 011056, Frame 0544.

***(2) Related Appeals and Interferences***

There are no other appeals or interferences known to Appellants, their Attorneys/Agents, or the Assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in the present appeal. Appellants' claims 34-37 on appeal are copies of claims 1-4, respectively, of U.S. Patent 6,947,067 to Halttunen. No interference has yet been declared between this application and Halttunen's patent.

***(3) Status of Claims***

The application has a total of fifty claims. Of these, claims 34-37 are pending and claims 1-33 and 38-50 are cancelled. Claims 34-37 stand finally rejected and are on appeal.

***(4) Status of Amendments***

An amendment was filed subsequent to the final rejection and was entered.

***(5) Summary of Claimed Subject Matter***

The subject matter of independent claim 34 is a method for transferring image and sound data from a mobile phone to a television. A system that may be used for practicing the method is shown in Figs. 1-3 of the application and described in the specification. Mobile phone "MS" may be a GSM-phone (Specification, page 6, line 32 to page 7, line 1). The acronym "GSM" stands for "Groupe Spécial Mobile," or in English "Global System for Mobile Communications" and is a standard for mobile phone communications. The mobile phone communicates with a network "N/W" over a radio link (Specification, page

7, lines 11-13) to receive image and sound data (Specification, page 7, lines 8-9; Fig. 2). The mobile phone generates a signal from the image and sound data and transmits that signal as an output signal (Specification, page 7, lines 14-16) in a format that conforms to a Bluetooth-protocol (Specification, page 7, lines 26-28). A link module “M1” located at a television “TV” receives the output signal from the mobile phone as an input signal (Specification, page 7, line 26; Fig. 1; Fig. 3) and converts the input signal to image-sound signals (Specification, page 8, lines 1-4). The link module has, for example, a SCART connector “SC1” and connects the image-sound signals to the television, for example through a second SCART connector “SC3” on the television (Specification, page 7, lines 23-24; Fig. 1). The acronym “SCART” stands for “Syndicat des Constructeurs d’Appareils Radiorécepteurs et Téléviseurs,” or in English “Television and Radio Manufacturer’s Association” and is a connector standard for conveying audio and video signals between pieces of audiovisual equipment. The link module may be located at the television by using a friction joint to attach the link module’s SCART output snugly to the television’s SCART input (Fig. 1; specification, page 6, lines 21-23).

***(6) Grounds of Rejection to be Reviewed on Appeal***

Appellants submit one ground of rejection for review:

- A. that the subject matter of claims 34-37 is unpatentable under 35 U.S.C. § 103(a) over European Patent Application EP0804030-A2 to Heinonen et al. (“Heinonen”) in view of U.S. Pat. No. 6,202,060 to Tran (“Tran”).

***(7) Argument***

- A. Claims 34-37 are patentable over Heinonen in view of Tran.

1. Summary of examination to date

Appellants presented claims 34-37 in an amendment filed December 5, 2005. A non-final rejection issued on May 31, 2006, and Appellants filed a response thereto on September 19, 2006.

In a final Office Action mailed November 20, 2006, and reiterated in the Advisory Action mailed February 9, 2007, the Examiner rejected claims 34-37 under 35 U.S.C. § 103(a) as encompassing subject matter unpatentable over Heinonen in view of Tran and further in view of general knowledge in the art. The Examiner took the position that Heinonen teaches all limitations of the claims except the requirement that the mobile phone output a signal in a format that conforms to a Bluetooth protocol. The Examiner argued that Tran describes a system in which display signals are transmitted from a mobile device to a coupling device wirelessly, and further took Official Notice that Bluetooth is a well-known protocol for wireless communication.

Following the rejection in the Office Action mailed November 20, 2006, Appellants' undersigned attorneys conducted an in-person interview with Examiner Sheleheda and Supervisory Examiner Kelley on January 18, 2007. During the interview, and in a subsequent response filed January 23, 2007, Appellants' attorneys argued that one of ordinary skill would not have found it obvious to modify Heinonen to provide a wireless Bluetooth connection from the mobile phone to the module: Heinonen expressly intends his physical connector 32 to transfer *both* data *and* charging power from charging accessory 7 to the mobile phone 6, but the Bluetooth protocol does not provide for power transmission of the magnitude that Heinonen requires for the charging function. So modifying Heinonen to employ a Bluetooth link would render Heinonen's system inoperable.

In response to Appellants' arguments, the Examiners took the position in the Advisory Action that Heinonen suggests that the data and power connections between the mobile phone and charging accessory can be separate. The Examiners pointed to Heinonen's col. 4, lines 48-55, in which Heinonen states that the "connector 32 may

include a data adapter or a data adapter may be connected between connector 32 and the mobile phone . . . . Such a data adapter is known e.g. as data cards for connecting a computer to a mobile phone.” Because, in the Examiners’ view, there existed data cards at the time that conveyed data but not power, Heinonen’s disclosure could be interpreted as permitting a power connection through some pins of connector 32 and a separate, parallel, data connection through other pins of connector 32. Consequently, the Examiners concluded, Heinonen was not incompatible with a wireless data connection conforming to a Bluetooth protocol.

2. The combination of references relies on impermissible hindsight, and would eliminate one of the specific advantages of the Heinonen reference.

In rejecting claims 34-37, the Examiner wrote on page 9 of the final action:

It would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Heinonen’s system to include transmitting the signal in a wireless format, as taught by Tran, *for the typical benefit of providing the user with greater mobility and flexibility by providing use of the system from anywhere within range of the television display[.]* (emphasis added)

Additionally, it would have been obvious to one of ordinary skill in the art at the time of invention by applicant to modify Heinonen and Tran’s system to include a format that conforms to a Bluetooth-protocol *for the typical benefits of conforming with a widely known protocol for establishing wireless local connections and eliminating the need for physical connections.* (emphasis added)

The italicized language appears to be the Examiner’s statement of the rationale for modifying Heinonen by Tran’s teachings, and specifying a Bluetooth protocol. But these statements merely point out beneficial outcomes that Appellants first recognized could be obtained by combining features arguably found in those references. It does not show how the cited references *themselves* suggest that features selected from them should be combined in the manner that Appellants later taught. Nor has the Examiner shown how anything known in the art at the time the present application was effectively filed would have led one of ordinary skill in the art to combine Heinonen, Tran, and knowledge in the art of Bluetooth. To the contrary, the Examiner has used Appellants’ own suggestion to

provide a wireless connection between a mobile phone and a television, and to enjoy the benefits this arrangement provides, as a blueprint for combining the cited art. This is impermissible hindsight. The desirability of combination must come from the prior art itself or the general knowledge, not from the Appellants. *In re Vaeck*, 947 F.2d 488,20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Appellants were the first to appreciate the advantages of providing a wireless link<sup>1</sup> between a mobile phone and a television, by way of a wireless connection between the phone and a module located at the television. Appellants discussed these advantages in their specification at page 3, lines 5-6:

An advantage of the present invention is that an external device, e.g. a mobile station, can be coupled to a television device using the open LPRF-standard, *in which case the coupling can be done easily independently of the make and model of the external device and the television device by using an easily portable adapter, which can quickly be installed by an ordinary consumer.* (emphasis added)

and at page 3, lines 20-28:

An LPRF-link allows communication between an external device and a television device *even if they have not been connected with wires and they do not have a direct line of sight or a proper reflection e.g. off a wall.* The user can also e.g. keep his/her mobile station on belt attached to a belt clip, *in which case the mobile station is in no danger of being left behind when the user leaves the place later.* (emphasis added)

Appellants thus invented a method that permits a user to keep the mobile phone on his or her person, free of the need to dock the phone in a charger, while sending image and sound data to the television.

Heinonen, in contrast, fails entirely to appreciate these advantages; instead, he describes a mobile phone charger accessory 30 that he has augmented with a data transfer capability. To this end, Heinonen provides a single connector 32 through which the charger accessory 30 exchanges both data and power with mobile phone 6 while the phone

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<sup>1</sup> An example of a wireless link disclosed in the application is a "Low-Power Radio Frequency" connection, or LPRF (Specification, page 2, line 18). Bluetooth is a type of LPRF (Specification, page 7, lines 26-27).

is physically docked in the charger (as shown in Heinonen's Fig. 1). Heinonen's stated goal is to *simplify and minimize* the equipment that consumers must buy to obtain new features (col. 1, lines 23-34). To this end, he devised a system that achieves all of his goals with a minimum of fuss: he allows users to conduct bidirectional communications using the mobile phone while simultaneously charging it.<sup>2</sup>

But the inappropriateness of combining Heinonen with wireless transmission of data such as by the Bluetooth protocol is not merely the fact that such a combination requires hindsight. It is worse than that. Not only is there no motivation to combine Heinonen with Bluetooth wireless transmission, but such a combination would require added complexity (the wireless transmission hardware) compared to the disclosed Heinonen system, while *it would offer no advantages whatever in the Heinonen system*. Heinonen's power-transmission to the mobile phone through connector 32 requires that connector 32 be a wired connection, and that the mobile phone be attached to it. Given this required physical connection, the addition of a wireless data transmission channel *in addition to* the connector 32 would not offer the advantage of mobility, and would not dispense with the need for a physical connection to the mobile phone, which are the major advantages of wireless communication cited, e.g., by the Examiner. Even if data were transferred over the hypothetical wireless connector, the mobile phone in Heinonen *still* would be required to remain tethered to the connector 32 in order to obtain power. There can be no motivation to graft a new feature onto an existing self-contained system, where the new feature would add no function whatever to the existing system, and therefore would solve no problem, and the new feature would offer no advantage over the existing system without the new feature.

By grafting a wireless data communication system onto Heinonen, the Examiners ignore Heinonen's purpose and goal of simplification, and indeed run counter to it. Heinonen would deter one of ordinary skill from introducing such complexity; Heinonen

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<sup>2</sup> Neither Appellants nor the real party in interest intend these comments to limit the scope of any claim issued in Heinonen's European Patent No. EP0804030B1, U.S. Pat. No. 5,990,882, or any other patent issuing from or claiming the benefit of Heinonen's Finnish patent application FI961800.

goes to the trouble of unifying the data and power transfer systems and provides a complete, self-contained system for achieving both. Heinonen presents his physical connection system as an adequate and sufficient solution for transferring power and data *by a single connector*. Moreover, Heinonen makes no suggestion that his particular system is in any way deficient or otherwise lacking in function. Similarly, Tran identifies no defect, disadvantage, or other shortcoming in Heinonen. In addition, no other prior art has been cited as suggesting the desirability of breaking apart Heinonen's simple system. To the contrary, claim 34 has been used by the Examiners as a blueprint for cobbling together disjoint pieces of cited art, which is an act of impermissible hindsight, and moreover for doing so in a way that adds no new or improved functionality to the cited art, and indeed introduces needless complexity, directly contradicting one of the purposes of the cited art.

Finally, despite the Examiners' assertion, the reference to a "data adapter" in Heinonen is not a suggestion that wireless data transmission may be utilized. Heinonen's reference to a data adapter at col. 4, lines 48-55, which the Examiner cites, is:

The connector 32 may include a data adapter or a data adapter may be connected between connector 32 and the mobile phone *for adapting data for sending it over a mobile phone system*, such as the GSM system, and also *for adapting data received over the mobile phone system to a format suitable for graphics chip 40*. Such a data adapter is known, e.g., as data cards for connecting a computer to a mobile phone. (Emphasis added.)

Thus, Heinonen refers to a data adapter, not to serve a communications function, or to replace the connector 32, but simply to convert data to and from mobile phone format, either as part of connector 32 or in addition to it. Heinonen does not envisage a data adapter replacing the physical connection made by connector 32, but simply as a device to carry out data format conversion, while connector 32 serves the communication (and power transmission) function.

For these reasons, Appellants ask that the rejection of claims 34-37 be reversed.

#### ***(8) Claims Appendix***

See pages 10 of this Appeal Brief.



***(9) Evidence Appendix***

See page 11 of this Appeal Brief.

***(10) Related Proceedings Appendix***

See page 12 of this Appeal Brief.

**CONCLUSION**

For the reasons given above, Appellants ask that the rejection of claims 34-37 be reversed.

Respectfully submitted,  
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***(8) Claims Appendix***

Claims 1–33 (Cancelled)

34. A method for transferring image and sound data from a mobile phone to a television, comprising:
- generating a signal in the mobile phone from the image and sound data received by the mobile phone;
  - transmitting the signal in a format that conforms to a Bluetooth-protocol as an output signal from the mobile phone;
  - receiving the output signal from the mobile phone as an input signal at a module;
  - converting the input signal to image-sound signals in the module; and
  - connecting the image-sound signals from the module to the television, wherein the module is a mobile telephone accessory located at the television.
35. The method according to claim 34, wherein connecting further comprises transmitting the image-sound signals to the television using a SCART-connection to the television.
36. The method according to claim 34, wherein the image-sound signals are a RGB+sound signal.
37. The method according to claim 34, wherein the television is an analog television.

Claims 38–50 (Cancelled)

***(9) Evidence Appendix***

None.

***(10) Related Proceedings Appendix***

None.